



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,201	07/10/2001	Trevor D. Schleiss	06005/37169	8312

4743 7590 03/09/2006

MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, IL 60606

EXAMINER

NGUYEN, PHUOC H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/902,201

Applicant(s)

SCHLEISS ET AL.

Examiner

Phuoc H. Nguyen

Art Unit

2143

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1-33.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See below.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Part 11: The applicant had argued the following points:


First, the applicant argued in page 10 fourth paragraph that the last Office action did not address the cited limitations for claims 10 and 27. The examiner respectfully submits that as generally addressed in the previous Office action, claims 10 and 27 are the system and method claims of claim 1 wherein claim 1 is a method claim with the most limitations. Every limitations cited under system and method claims 10 and 27 respectively is generally covered in claim 1, even though claim language is cited slightly difference. Thus, claims 10 and 27 are reasonable to be rejected under the same rationale as cited in the rejection of rejected claim 1.

Second, the applicant argued in page 10 last paragraph that it is not obvious to combine the references by Dodge et al. in view of Swamy et al. to disclose the claimed invention because the modification proposed in the Office action would change the principle of operation of the system and method of Dodge et al.. The examiner respectfully submits that it is obvious and reasonable to combine the references by Dodge et al. and Swamy et al. because the combination does not change the principle of operation of the primary reference but rather it enhances the performance of the primary reference by extending the communication with one of plurality partners. In this case, the plurality partners would be the plurality remote systems as seen in Figures 1 and 5 wherein the remote system(s) and the welder are operatively and communicatively through a predetermined or dedicated format(s) including XML, but the reference clearly did not disclose all the remote systems must use the same predetermined or dedicated format(s) to communicate with the welder. Thus, it is obvious and reasonable to add the extended feature of secondary reference as mapping an xml information format to another xml schema format into the primary reference for enhancing the system performance as be able to communicate with all the remote system(s) in plurality format(s).

Third, the applicant argues in page 11 first paragraph that the system and method of Dodge et al.'s invention does not require mapping the information from a source schema to a target schema as taught by secondary reference Swamy et al. The examiner respectfully admits that the primary reference by Dodge et al. did not require the mapping of information from one source schema to a target schema as taught by the secondary reference by Swamy et al. However, the primary reference inherently encounters a problem when communicates with plurality of remote systems using plurality of schemas. This problem of primary reference can be overcome by an ordinary skill person in the art of technology given the technology cited in the secondary reference.

Fourth, the applicant argues in pages 11-12 that the assumption made by Examiner of different remote entities as the different business partners is unacceptable for combining with different mapping schema(s). The examiner respectfully submits that the current claim language does not clearly cite a particularly system or application at the received end. Thus, as long as the remote entities or the different kind of business partners at the received end use different xml schema formats to communicate with the welder, then it is obvious to combine the references to meet the claimed invention.

Fifth, the applicant further argues in page 13 that it is insufficient to establish a case of obviousness because the proposed modification would require a substantial reconstruction and redesign of the system and method of Dodge et al. and a change the basic principle under which it was designed to operate. The examiner respectfully submits that the combination does not require a substantial reconstruction and or redesign of the system and method as argued by the applicant, but rather it is a simple extended system or method of communication. The primary reference discloses the overall communication of welder and plurality of remote systems using XML format. The secondary reference discloses a technology of converting or mapping an XML format to another XML schema format. Thus, combination the references by adding the technology by secondary reference to the end of the primary reference's invention would enable to communicate with plurality of remote systems using plurality xml format as generally claimed by the applicant.


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100